



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/691,427	10/18/2000	George H. Beall	SP00-321	4916

22928 7590 04/22/2003

CORNING INCORPORATED
SP-TI-3-1
CORNING, NY 14831

EXAMINER

HOFFMANN, JOHN M

ART UNIT	PAPER NUMBER
----------	--------------

1731

DATE MAILED: 04/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/691,427

Applicant(s)

BEALL ET AL.

Examiner

John Hoffmann

Art Unit

1731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 March 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6,8,9 and 11-21 is/are pending in the application.
- 4a) Of the above claim(s) 18-21 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 13 is/are allowed.
- 6) ☒ Claim(s) 1-6,8,9,11,12 and 14-16 is/are rejected.
- 7) ☒ Claim(s) 18-21 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

The amendment is not understood. Page 16 of the amendment of 18 March 2003 indicates that claims 18-21 are to be cancelled- as they are lined through. However, page 1 of that amendment states " Cancel claims 7 and 10" . There is no corresponding instruction to cancel claims 18-21. It is unclear what the status should be for these claims. They remain withdrawn from consideration, but they are also objected to - for being of unclear status.

Although it was previously indicated that the claims (as now presented) would be allowed, further review of the claims indicated that there are some things that would make it difficult for one of ordinary skill to understand, and thus the following rejections are made.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-6, 8-9, 11-12 and 14-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "glass ceramic optoelectronic material" is indefinite as to its meaning. Alternatively or additionally, the term is misleading. One of ordinary skill realizes that

the glass-ceramic disclosed is an electrical insulator and thus it cannot possess any optoelectronic properties as one usually interprets "optoelectronic". Applicant must be using a totally new definition for "optoelectronic" - this is generally not permitted - especially since the present disclosure fails to indicate what this new definition is. Alternatively, the term "glass ceramic optoelectronic material" is being used to indicate a glass-ceramic material (which doesn't possess any optoelectronic property), which material is used in an optoelectronic device. This usage is also unacceptable, because the Disclosure did not define it as such, and because that isn't how one of ordinary skill would interpret such language. It is noted that an is not permitted to define terms during prosecution. It is noted that any arguments pertaining to this term, may be used in a future rejection for lack of enablement under 35 USC 112, first paragraph.

Claim 1: there is confusing antecedent basis for the materials: line 1 refers to "glass ceramic optoelectronic material", lines 4 and 10 refers to "glass ceramic", line 11 refers to "the optoelectronic material" and line 13 refers to (hyphenated) "glass-ceramic". It is unclear if these are all the same thing. Most notably one line indicates that the glass ceramic is in the form of the fiber and another section indicates that the optical material is only the core of the fiber. So this suggests they are two different things. This problem is most evident at claim 9 which states the fiber is made of glass - which is impossible because claim 1 claims that the fiber is of an optoelectronic (glass ceramic?) material.

Claim 2: refers to "the optically active ion" however claim 1 mentions a "kind" of ion. It is unclear claim 1 should be interpreted as one ion, or if claim 2 should be interpreted as referring to a "kind" of ion. Furthermore, claim 2 is not of a proper Markush group and therefore one cannot tell what it is limited to. Compare to present claims 3 and 9 which have proper Markush language: the group "consisting of" of its members - it is not open to any other metals. It is also noted that a metal is not a ion; claim 2 should state "transition metal ions and lanthanide ions".

Claims 4 and 5 have an improper Markush group and are not understandable. A proper Markush group would have an "and" rather than an "or" in the last line. See MPEP 2173.05(h). Claim 8 also has an improper Markush group.

Claims 3-5 refer to "the transition metals with which the glass-ceramic is doped" or "the lanthanides..." There is no antecedent basis for this. As a minor point, it is the ions of the metals which are doped. As a significant point: claim 1, step a) merely states that the glass is "for" a doped glass ceramic. There is no recitation that a dopant is actually contained in the process. The precursor glass can be a host glass to which the ions are eventually added to. Therefore, there is no antecedent basis for "the ion", "the kind", "the transition metal", or "the lanthanide".

Furthermore claims 3-5 refer to the ions/metals/elements in the plural - there is no indication that in claim 1 that there must "metals" or "lanthanides". One would be uncertain as to what the claims require.

Claim 12: it is unclear if "temperature" is missing after "crystallization" in line 7, and if it is not missing, it is unclear what the claim requires. Could it be "crystallization nucleation"?

Claims 14-16 depend from claim 1. From the MPEP 608.01(n) III:

"Examiners are reminded that a dependent claim is directed to a combination including everything recited in the base claim and what is recited in the dependent claim. It is this combination that must be compared with the prior art, exactly as if it were presented as one independent claim."

Therefore, when one makes the combination of claim 1 with the dependent claims, there exists a lack of antecedent basis for "the glass fiber" as recited in dependent claims 14-16. Although claim 1 is open to having a fiber made of glass, such is not explicitly or implicitly required.

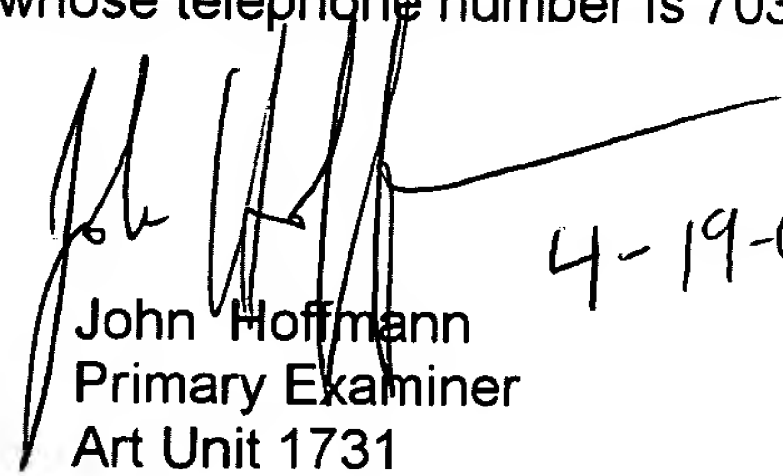
Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Hoffmann whose telephone number is 703-308-0469. The examiner can normally be reached on Monday through Friday, 7:00- 3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steve Griffin can be reached on 703-308-1164. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7115 for regular communications and 703-305-3599 for After Final communications.

Application/Control Number: 09/691,427
Art Unit: 1731

Page 6

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0651.


John Hoffmann
Primary Examiner
Art Unit 1731

4-19-03

jmh
April 19, 2003